

REMARKS

STATUS OF THE CLAIMS

New independent claim 51 has been added. Pending independent claim 38 has been amended to clarify certain claim elements and to include a clamp assembly as recited in claim 51.

Claims 22, 23, 25-27, 30, 31, 39 and 42-50 have been canceled to expedite prosecution and without prejudice to their presentation in a continuing application.

THE OFFICE ACTION

In the Office Action of December 16, 2009, the Office rejected

1. claims 2-16, 20-35 and 37-50 under 35 U.S.C. 112 second paragraph as being indefinite;
2. claims 2-16, 20-35, 37, 38, 39, and 40-45 under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 3,493,206 to Albro (“Albro”); and
3. claims 2-16, 20-35, 37, 38, 39 and 40-50 under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 2,246,557 to Walters (“Walters”).

INDEFINITENESS

The Office has rejected claims 2-16, 20-35 and 37-50, asserting that the terms “lower,” “above,” “upwardly,” “horizontally,” and “vertically” are indefinite.

Applicant, without conceding that those terms are indefinite in the context of the present invention, has amended the claims to remove those terms.

Therefore, this ground of rejection is now moot and its withdrawal is respectfully requested.

ANTICIPATION BY ALBRO

THE OFFICE HAS NOT REJECTED CLAIMS 2-16, 20-35, 37, 38, 39, AND 40-45.

The Office rejects claims 2-16, 20-35, 37, 38, 39, 40, and 41 by stating that

In regards to [independent] claims 38, 39 and 42, in Figures 1 and 3 below, Albro discloses a combination of a coupling member (10), an electrical wire-carrying conduit (P), and a connecting member (15) for positioning and securing said conduit to a remote supporting structure, said combination comprising:

an said electrical wire-carrying conduit having opposite ends;

a said coupling member receiving and supporting said conduit, said coupling member comprises a tubular member having a longitudinal axis and at least one end, said end receiving one end of said conduit along said longitudinal axis, and said tubular member having a wall containing an aperture facing the remote supporting structure; and

said connecting member having opposite ends, one end of said connecting member securely engaging said aperture in said wall of said tubular member, the opposite end of said connecting member extending outwardly beyond said wall and upwardly toward said remote structure and,

a clamp assembly (17), said opposite end of said connecting member engaging said clamp assembly which is adapted to securely engage the remote supporting structure along its elongated surface, to securely hold and support said coupling member and said conduit in a selected position, and to be removably engageable to said remote supporting structure.

Office Action, page 3.

Except for the addition of the drawing element numbers (10, p, and 15) and the use of the indefinite article before “said electrical wire-carrying conduit” and “said coupling member”, this

is the exact language of independent claim 38. Consequently, Albro has not been applied to any other independent claim. Further, Applicant submits that independent claims 38, 39 and 42 have not been properly rejected under the statute and the rules.

Albro has not been applied against independent claims 39 and 42. Therefore, the Office has conceded that independent claim 39 and 42 are not anticipated by Albro .

The Office has not applied Albro at all against claims 37 and 46-50. Therefore, the Office has conceded that claims 37 and 46-50 are not anticipated by Albro.

Applicant submits that Albro has not been adequately applied against dependent claims, 2-16, 20-36, 40, and 43-45.

THE REJECTION IS NOT COMPLIANT WITH 35 U.S.C. 132 AND 37 C.F.R. 1.104(C)(2).

Section 132 (35 U.S.C.A. 132) requires that

35 U.S.C. 132 Notice of rejection; reexamination.

(a) Whenever, on examination, any claim for a patent is rejected, or any objection or requirement made, the Director shall notify the applicant thereof, stating the reasons for such rejection, or objection or requirement, together with such information and references as may be useful in judging of the propriety of continuing the prosecution of his application; and if after receiving such notice, the applicant persists in his claim for a patent, with or without amendment, the application shall be reexamined. No amendment shall introduce new matter into the disclosure of the invention.

Rule 104(c)(2) (37 C.F.R. 1.104(c)(2)) requires that

(c) *Rejection of claims.*

* * * * *

(2) In rejecting claims for want of novelty or for obviousness, the

examiner must cite the best references at his or her command. When a reference is complex or shows or describes inventions other than that claimed by the applicant, the particular part relied on must be designated as nearly as practicable. The pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified.

Applicant respectfully submits that the statement of a ground for rejection and the recitation of the text of a single rejected independent claim is not compliant with either the statute or the rules.

While the Office has stated its conclusion, it has not given any supporting reasoning.

Applicant's device allows connectors to be placed at any convenient position along a supporting structure. The prior art required constructing a separate, fixedly and precisely positioned supporting structure placed only after the connector is positioned; a threaded holder, fixed to the beam or ceiling accurately positioned to be connected to the connectors. Such a holder requires its construction only after the conduit and coupling member is positioned to know where to place the holder. Also, the prior art structures require at least two persons to position, one to hold the conduit and the other to align and fix the holder. The device disclosed in this application requires only one (1) person to fix the clamp to the beam anywhere along its length, convenient to the conduit to be supported.

None of these advantages are obtainable with the cited art.

THE OFFICE HAS NOT ESTABLISHED A PRIMA FACIE CASE OF ANTICIPATION BY ALBRO.

In order to establish a *prima facie* case of anticipation, each and every element in the claim must be found in the reference. See, MPEP ¶ 2131 as follows:

TO ANTICIPATE A CLAIM, THE REFERENCE MUST TEACH
EVERY ELEMENT OF THE CLAIM

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

Applicant respectfully submits that the statement of a ground for rejection and the recitation of the text of a single rejected independent claim does not establish a *prima facie* case of anticipation.

ALBRO DOES NOT ANTICIPATE CLAIMS 38 OR 51.

Applicant submits that Albro does not anticipate for at least the basis that Albro discloses an adjustable pipe hanger. Albro states

Referring first to FIG. 3, a split cradle member 10 which, for example, may be formed of a plastic material such as Type 1 polyvinyl chloride, is provided with an inner diameter which when the hanger is installed to support pipe P will afford a suitable clearance for such pipe.

The cradle member 10 is not a coupling member. A cradle is not a coupling. *See*, McGraw-Hill Dictionary of Scientific and Technical Terms, Second Edition (1978), as follows:

Cradle. [ENG] A framework or resting place for the supporting or restraining objects.

McGraw-Hill Dictionary of Scientific and Technical Terms, Second Edition (1978), page 375.

Coupling. [ENG] Any device that serves to connect the ends of adjacent parts, as railroad cars.

McGraw-Hill Dictionary of Scientific and Technical Terms, Second Edition (1978), page 373.

Further, the drawing element 17 in Figures 1 and 3, of Albro that the Office relies on as disclosing the claimed clamp assembly is not a clamp assembly. Albro describes element 19 as a plate screwed into place. (See col. 3, lines 1-3).

Applicant submits that Albro does not disclose the clamp assembly as recited in claims 38 and 51 in spirit or actual construction.

ANTICIPATION BY WALTERS

THE OFFICE HAS NOT REJECTED CLAIMS 2-16, 20-35, 37, 38, 39 AND 40-50.

The Office rejects claims 2-16, 20-35, 37, 38, 39 and 40-50 by stating that

In regards to claims 38, 39, 42, 46 and 50, in Figures 1-3 and 10 below, Walters discloses a combination of a coupling member (7), an electrical wire-carrying conduit (2,2'), and a connecting member (25) for positioning and securing said conduit to a remote supporting structure having an elongated surface above said coupling member, said combination comprising:

an said electrical wire-carrying conduit having opposite ends;

said coupling member receiving and supporting said conduit, said coupling member comprises a tubular member having a longitudinal axis and at least one end, said end receiving one end of said conduit along said longitudinal axis, and said tubular member having a wall containing an aperture facing the remote supporting structure above said coupling member; and

said connecting member having opposite ends, one end of said connecting member securely engaging said aperture in said wall of said tubular member, the opposite end of said connecting member extending outwardly beyond said wall and upwardly toward said remote structure and

a clamp assembly (22), said opposite end of said connecting member engaging said clamp assembly which is adapted to securely engage the remote supporting structure selectively along its elongated surface, to securely hold and support said coupling member and said conduit in a selected position, and to be removably engagable to said remote supporting

structure.

Office Action, pages 10 and 11.

Except for the addition of the drawing element numbers (7, 2, 2', 22 and 25) and the use of the indefinite article before "said electrical wire-carrying conduit", this is the exact language of independent claim 38. Consequently, Walters has not been applied to any other independent claims.

THE REJECTION IS NOT COMPLIANT WITH 35 U.S.C. 132 AND 37 C.F.R. 1.104(c)(2).

Section 132 (35 U.S.C.A. 132) requires that

35 U.S.C. 132 Notice of rejection; reexamination.

(a) Whenever, on examination, any claim for a patent is rejected, or any objection or requirement made, the Director shall notify the applicant thereof, stating the reasons for such rejection, or objection or requirement, together with such information and references as may be useful in judging of the propriety of continuing the prosecution of his application; and if after receiving such notice, the applicant persists in his claim for a patent, with or without amendment, the application shall be reexamined. No amendment shall introduce new matter into the disclosure of the invention.

Rule 104(c)(2) (37 C.F.R. 1.104(c)(2)) requires that

(c) Rejection of claims.

* * * * *

(2) In rejecting claims for want of novelty or for obviousness, the examiner must cite the best references at his or her command. When a reference is complex or shows or describes inventions other than that claimed by the applicant, the particular part relied on must be designated as nearly as practicable. The pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified.

Applicant respectfully submits that the statement of a ground for rejection and the recitation of the text of a single rejected independent claim is not compliant with either the statute or the rules. While the Office has stated its conclusion, it has not given any supporting reasoning.

THE OFFICE HAS NOT ESTABLISHED A PRIMA FACIE CASE OF ANTICIPATION BY WALTERS.

In order to establish a *prima facie* case of anticipation, each and every element in the claim must be found in the reference. See, MPEP ¶ 2131 as follows:

TO ANTICIPATE A CLAIM, THE REFERENCE MUST TEACH
EVERY ELEMENT OF THE CLAIM

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

Applicant respectfully submits that the statement of a ground for rejection and the recitation of the text of a single rejected independent claim does not establish a *prima facie* case of anticipation.

WALTERS DOES NOT ANTICIPATE CLAIMS 2-16, 20-35, 37, 38, 39 AND 40-50.

Applicant submits that Walters does not anticipate for at least the basis that Walters discloses an adjustable pipe hanger that does not provide

a clamp assembly comprising

i) a clamp body having a generally C-shape configuration and comprising

(1) a first arm having opposite ends and having a generally smooth, flat surface

- (2) a second arm having opposite ends and spaced from and having a surface generally parallel to said flat surface of said first arm and moveable thereto,
 - (3) a web connecting one end of said first arm and a corresponding one end of said second arm, and
 - (4) each of said first arm and said second arm having threaded apertures extending therethrough, and
- ii) a threaded member threaded through said threaded aperture of said second arm for threaded adjustment,
 - iii) said opposite end of said connecting member threaded through said first arm aperture for threaded adjustment of said first and second arms,

The drawing element 22 of Walters that the Office relies on as disclosing the claimed clamp assembly is not a clamp assembly. Walters describes element 22 as follows:

“The connector 1 is mounted on the supporting member 3 by means of trunnions 20 which extend from diametrically opposite sides of the sleeve 6 of the connector. The supporting member 3 is in the form of a yoke or forked U-shaped member comprising a base plate 21 having vertically extending side portions 22, which terminate at their upper ends in mutilated eyes 23 having elongated slots 24 provided therein through each of which a bolt 25 is adapted to pass, said bolt being threaded into a socket 26 provided in each of the trunnions 20.”

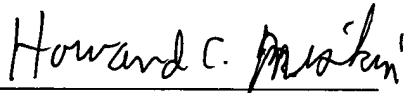
page 2, right hand column, lines 27-39

For the reasons discussed above with respect to the rejection of Albro, similarly here, Walters does not teach the structure disclosed and claimed.

CONCLUSION

By virtue of the foregoing amendments to the claims and remarks, Applicant submits that all outstanding grounds of rejection have been addressed and dealt with and, based thereon, submits that the application is now in condition for allowance and such action is respectfully solicited.

Respectfully submitted,



Howard C. Miskin, Esq.
Reg. No. 18,999
Attorney for Applicant
MISKIN & TSUI-YIP, LLP
1350 Broadway, Suite 802
New York, NY 10118
(212) 268-0900